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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/017,394

12/18/2001

Kazuhiro Hayashi

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10/04/2006

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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT

PAPER NUMBER

2145

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/017,394

Applicant(s)

HAYASHI ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/17/06 has been entered.

### ***Response to Arguments***

2. Applicant is requested to adhere to the objection to the specification, herein made for the third time during the prosecution of this application. The United States Patent system exists to award an inventor the exclusive rights to an invention in exchange for a description of the invention being presented to the public. The current quality of the specification does not allow the public to gain an accurate description of the invention. The specification is apparently a machine translation of the original Japanese specification. The machine translation is confusing, unclear, and makes no sense in several locations. These errors could easily be corrected by having a person read over the specification and make grammatical corrections. The current specification is so unclear that one of ordinary skill in the art cannot ascertain all of the operational aspects and characteristics, mainly due to poor and incomprehensible wording. It is not the responsibility of the Office to point out each and every grammatical error in the specification to the Applicant. Applicant has the burden of presenting a comprehensible specification to the Office.

3. Claims 1-18 are again rejected under 35 U.S.C. 112, second paragraph because the claims are not comprehensible and riddled with idiomatic English. One of ordinary skill in the art is unable to clearly understand what Applicant's invention is, for at least the reasons that the specification is objected to above. Applicant must clarify the claims by amendment to allow one of ordinary skill in the art to comprehend the claims in a manner to allow the invention to be built.

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4. Applicant alleged Herz failed to disclose a plurality of second information pieces including content information pieces indicating contents of the first information pieces or attribute information pieces indicating attributes of the first information pieces. The first information pieces are the videos in Herz. The second information pieces including content information pieces indicating contents of the first information pieces or attribute information pieces indicating attributes of the first information pieces are the content profiles (column 11, line 32 in one instance) of the videos in Herz. This is in a "one-to-one correspondence" as defined in the claim.

5. Applicant alleged Herz failed to disclose when the outputted second information piece, updated at the terminal, is returned from the terminal, the storage control section stores the returned second information pieces in place of the second information pieces before outputting in the corresponding information section. Applicant is initially urged to clarify the wording of this phrase, as was pointed out in the rejections under 35 U.S.C. 112, second paragraph, because this clause is highly confusing and difficult to construe. As best construed by the current status of the claim, the matrix in column 15, lines 45-65 meets this limitation. Applicant failed to provide a clear limitation for examination purposes.

6. With regard to buffering, Applicant alleges the Office's statement of inherency is improper and incorrect. Applicant makes a mere allegation that the Office is incorrect, without providing evidence. Once the Office establishes inherency, the burden shifts to Applicant to show how the invention is not inherent. MPEP 2112. Applicant is requested to provide evidence showing how data can be transmitted without being stored in a buffer, register, or any other form of memory before being sent through a network transmission card.

7. The previous paragraph is also applicable to the double patenting rejection against Hayashi. Applicant's sole argument is the alleged lack of inherency as attributed by the Office. The Office is unaware of any functional networking device that does not store data in some format, either permanently or temporarily, during data packetization, transmission, or other functions. Applicant must provide evidence that such a device exists, and how such a device would function, including what networking protocol such a device would employ.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The claims are generally narrative and indefinite, failing to conform with current U.S. practice.

They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz et al. (U.S. Patent No. 5,758,257).

13. In regard to claim 1, Herz discloses *a storage section for storing a plurality of first information pieces; a corresponding information storage section for storing a plurality of second information pieces in one-to-one correspondence with the plurality of the first information pieces, the second information pieces including content information pieces indicating contents of the first information pieces or attribute information pieces indicating attributes of the first information pieces; an output section for outputting the first information pieces to be outputted to a terminal together with the second information pieces corresponding to the first information pieces to be outputted; and a storage control section, wherein when the outputted second information piece, updated at the terminal, is returned from the terminal, the storage control section stores the returned second information pieces in place of the second information pieces before outputting in the corresponding information storage section.* Herz discloses a distribution system for video programming that stores available video programming and matches it to a content profile and a

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user profile. The content profiles describe the contents of video programs. An "agreement matrix" is kept that regularly updates the correlation of preferences based upon how many customers view the video, user preferences, and other factors. See Herz, column 9, line 60 – column 10, line 53. See Herz, column 4, lines 32-43 and lines 51-58 and column 3, lines 60-67 and column 6, lines 35-66.

14. In regard to claim 2, Herz is applied as in claim 1. Herz further discloses *the second information pieces include the content information pieces and the attribute information pieces*. Herz uses content profiles to describe available programming. See Herz, column 9, line 60 – column 10, line 16.

15. In regard to claim 3, Herz is applied as in claim 2. Herz further discloses a *batch information storage section for storing batch information which indicates the contents and attributes of all information pieces stored in the storage section, wherein the output section outputs the batch information together with the first information pieces and the second information pieces to the terminal; and when the output batch information is returned from the terminal, the storage control section stores the returned batch information in the batch information storage section in place of the batch information before outputting*. Herz sends an electronic programming guide to the user as well as the programming. The program guide is updated based on what the viewer watches. Column 22, line 56 – column 23, line 10.

16. In regard to claim 4, Herz is applied as in claim 3. Herz further discloses *the batch information includes batch content information which collectively indicates the contents of all first information pieces stored in the storage section or batch attribute information which collectively indicates the attributes of all first information pieces*. Herz discloses a programming guide describing what will be shown on a virtual channel. See Herz, column 23, lines 1-10.

17. In regard to claim 5, Herz is applied as in claim 3. Herz further discloses *the batch information includes at least batch content information which collectively indicates the contents of all first information pieces stored in the storage section and batch attribute information which collectively indicates the attributes of all first information pieces*. Herz discloses a programming guide describing what will be shown on a virtual channel. See Herz, column 23, lines 1-10.

18. In regard to claim 6, Herz is applied as in claim 1. Herz further discloses *the first information pieces are a plurality of music; the content information pieces are titles of the pieces of music, and the*

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*attribute information pieces are utilization information pieces indicating degree of to which the pieces of music are utilized in the terminal.* Herz states that his invention may be utilized for music selection in column 4, lines 34-37. The content and user profiles in column 9, line 60 – column 10, line 53 in a music selection embodiment would be *titles of the pieces of music and degree of to which the pieces of music are utilized in the terminal.*

19. Claim 7 has substantially the same limitations as claim 1, and the rejection of claim 1 is equally applicable against claim 7.

20. Claim 8 has substantially the same limitations as claim 2, and the rejection of claim 2 is equally applicable against claim 8.

21. Claim 9 has substantially the same limitations as claim 3, and the rejection of claim 3 is equally applicable against claim 9.

22. Claim 10 has substantially the same limitations as claim 4, and the rejection of claim 4 is equally applicable against claim 10.

23. Claim 11 has substantially the same limitations as claim 5, and the rejection of claim 5 is equally applicable against claim 11.

24. Claim 12 has substantially the same limitations as claim 6, and the rejection of claim 6 is equally applicable against claim 12.

25. Claim 13 has substantially the same limitations as claims 1 and 3, and the rejections of claims 1 and 3 are applied against claim 13.

26. In regard to claim 14, Herz is applied as in claim 13. The additional limitations of claim 14 are substantially the same as the limitations of claim 2, and the rejection of claim 2 is applied against claim 14.

27. Claim 15 has substantially the same limitations as claim 1, and the rejection of claim 1 is equally applicable against claim 15.

28. Claim 16 has substantially the same limitations as claim 2, and the rejection of claim 2 is equally applicable against claim 16.

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29. Claim 17 has substantially the same limitations as claim 1, and the rejection of claim 1 is equally applicable against claim 17.

30. Claim 18 has substantially the same limitations as claim 2, and the rejection of claim 2 is equally applicable against claim 18.

### ***Double Patenting***

31. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

32. Claim 1 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,831,798 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both the instant application and the patent refer to storing a plurality of information including a first partial information and a second partial information and reproducing said partial informations.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Art Unit 2145